The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FREDERICKA D. LAM and MICHAEL R. LAM

MAILED
AUG 2 8 2006
U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2006-1990
Application No. 10/678,231
Technology Center 3722

ON BRIEF

Before FRANKFORT, OWENS, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-18, 20, 21, 23-28, 30, 31 and 33-58, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to an artificial eye (specification, page 1). In particular, the lens for the eye is made from a natural or synthetic material having a density and hardness greater than glass. One preferred material for the lens is cubic zirconium, which has a MOS hardness of about 8.0 (specification, page 2).

Claim 1 is representative of the invention, and is reproduced as follows:

An artificial eye comprising:

a base; and

a lens-lamina structure, attached to said base, comprising:

a lens having a substantially flat backside, said lens comprising a natural material selected from the group consisting of diamond, sapphire, topaz, beryl, quartz, zircon, and ruby; and

a lamina attached to said backside of said lens.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Smith	3,480,971	Dec. 2, 1969
Deeg et al. (Deeg)	4,079,470	Mar. 21, 1978
Nasca	4,601,673	July 22, 1986

Claims 1-18, 20, 21, 23-28, 30, 31 and 33-58 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nasca in view of Deeg.

Claims 1-4, 9-12, 17, 18, 20, 21, 23-25, 27, 28, 30, 31, 33-35, 37-46 and 51-54 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Deeg.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed October 20, 2005) for the examiner's complete reasoning in support of the rejections, and to the supplemental brief (filed March 2, 2005) and reply brief (filed December 19, 2005) for the appellants' arguments thereagainst.

Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered. See 37 CFR § 41.37(c)(1)(vii)(eff. Sept. 13, 2004).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by

the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we make the determinations which follow. We begin with the rejection of claims 1-18, 20, 21, 23-28, 30, 31, and 33-58 under 35 U.S.C. § 103(a) as being unpatentable over Nasca in view of Deeg. We observe at the outset that appellants argue the claims together as a group. Accordingly, we select claim 1 as representative of the group. Turning to claim 1, we note as background that in rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed

invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The examiner's position (answer, page 3) is that Nasca does not disclose the lens to be made from the natural material selected from the group consisting of "diamond, sapphire, topaz, beryl, quartz, zircon, and ruby." To overcome this deficiency

of Nasca, the examiner turns to Deeg for a teaching of "an artificial eye comprising the aforementioned limitation." The examiner's reasoning (answer, page 4) is that the modification would enhance the durability of the artificial eye.

Appellants' position (brief, page 6) is that the specific differences between Nasca and Deeg is that the lenses are entirely different structures, are used for different purposes, and are made of entirely different materials. In Deeg, the function of the lens is to focus images on the retina of a natural eye. The lens is mounted on the iris of a natural eye, and has no effect on the appearance of the natural eye. In Deeg, the criteria for selecting the material for a replacement lens of a natural eye is to reduce the weight of the lens while maintaining chemical stability and biological inertness, and (brief, page 8) suitable refractive index.

Turning to Nasca, appellants assert that the difference lies in the density, hardness and sparkle of the lens. It is argued (brief, page 9) that the structure, function, and criteria for lenses and lens materials for artificial eyes on the one hand and for natural eyes on the other are totally different, and that there is no teaching, suggestion or motivation in Nasca or Deeg

that the materials disclosed in Deeg for use in replacement of lenses in natural eyes would be appropriate for use in lenses for Nasca's artificial eye.

The examiner responds (answer, page 5) that "in this case, the Deeg et al. reference was combined with the Nasca and Smith references merely to teach the concept of having a lens for an eye being made of the various materials recited in the claims on appeal." The examiner (id.) points to the disclosure of Nasca that the lens could be colored or pigmented for aesthetic purposes. The examiner adds that the structural differences between the eyes of Nasca and Deeg is irrelevant because Deeg primarily focuses on the lens for an eye and the materials used for the lens.

In the reply brief, appellants assert (reply brief, page 2) that Deeg does not teach that hardness and durability are desirable characteristics of replacement lenses for natural eyes. It is further argued that Nasca relates to an artificial eye that is a cosmetic appliance. One skilled in the art of artificial eyes would not be motivated to employ the materials used in medical procedures (as in Deeg) for treating human eyes.

From our review of the record, it is clear that the references include disclosure of all of the limitations of

appellants' claims. The issue therefore, is whether an artisan would have been motivated to use the lens materials of Deeg in the artificial eye of Nasca. From our review of Nasca, we find that the reference relates to artificial eyes for use in toys such as dolls, and for use in mannequins (col. 1, lines 6-8). The lens (cornea 24) may be colored or pigmented to eliminate the iris 22 (col. 4, lines 21 and 22).

Turning to Deeg, the reference is not drawn to an artificial eye as asserted by the examiner (answer, page 3). Rather the reference is drawn to a replacement lens for a natural eye. As illustrated in Figure 1, replacement lens 10 is secured to iris 14 by connectors 16, 18. Deeg discloses that there is an ongoing need and search in the art for a desirable way to reduce the net weight of implantable lenses (col. 1, lines 28-30). Deeg discloses the use of a plurality of natural and synthetic materials to use for the replacement lenses (see the table at the bottom of column 2). From the disclosure of Nasca as being directed to an artificial eye for a doll, and the disclosure of Deeg of the need to reduce the weight of a replacement lens for use in a human eye, we find no motivation to combine the teachings of the references because there is no disclosed or suggested need of reducing the weight of the replacement eye in a

doll. The doll is inanimate, and would not be affected by a higher weight of the artificial eye used. Accordingly, we agree with appellants for the reasons set forth in the brief, as amplified by our comments, that an artisan would not have been motivated to combine the teachings of Nasca and Deeg, absent appellants' disclosure. "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para- Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995)(citing W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983)). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992)(citing In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991)).

Although couched in terms of combining prior art references, the same requirement applies in the context of modifying such a reference. Here, the examiner's broad, conclusory opinion of obviousness does not meet the requirement for actual evidence.

From all of the above, we find that the combined teachings of Nasca and Deeg would not have suggested the invention of claim 1. Accordingly, we cannot sustain the rejection of claim 1 under 35 U.S.C. § 103(a). In addition, because all of the other independent claims also require the listed natural or synthetic materials found only in Deeg, we likewise cannot sustain the rejection of claims 2-18, 20, 21, 23-28, 30, 31, and 33-58 under 35 U.S.C. § 103(a).

We turn next to the rejection of claims 1-4, 9-12, 17, 18, 20, 21, 23-25, 27, 28, 30,31,33-35, 37-46 and 51-54 under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Deeg. Appellants assert (brief, page 9) that the arguments presented above concerning the propriety of combining Nasca and Deeg apply equally to the combination of Smith and Deeg. It is argued (id.) that "in this case, the Deeg et al. reference was combined with the Nasca and Smith references merely to teach the concept of having a lens for an eye being made of the various materials recited in the claims on appeal." The examiner's position can be found on page 4 of the examiner's answer. From our review of Smith, we find that the reference is directed to an artificial eye for a human, that includes a mechanism for pressing against an eye muscle of a user to give the appearance of a normal eye

which moves in the eye socket (Figure 5). Because Smith discloses an artificial eye that does not provide sight to the user, we find no teaching to replace the painted iris with a lens used for providing sight to a person lacking a lens, other than from appellants' disclosure. Accordingly, we cannot sustain the rejection of claims 1-4, 9-12, 17, 18, 20, 21, 23-25, 27, 28, 30,31,33-35, 37-46 and 51-54, for the reasons advanced by appellants.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-18, 20, 21, 23-28, 30, 31 and 33-58 under 35 U.S.C. § 103 is reversed.

REVERSED

Charles E. Frankfort

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